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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------------|------------------|
| 10/686,196   | 10/15/2003  | Gregory A. Shteyngarts | 16-471                    | 5909             |
| 7590 03/10/2005<br>WATTS, HOFFMANN CO., L.P.A.<br>Ste. 1750<br>1100 Superior Ave.<br>Cleveland, OH 44114 |             |                        | EXAMINER<br>ALIE, GHASSEM |                  |
|  |             |                        | ART UNIT<br>3724          | PAPER NUMBER     |

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/686,196

Applicant(s)

SHTEYNGARTS, GREGORY A.

Examiner

Ghassem Alie

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 and 26, drawn to a trim press including a heater that is in direct contact with the knife element and a die travel stop, classified in class 83, subclass 124.
  - II. Claims 9-15, drawn to a trim press including a die travel stop having a generally conical recess and a post element that protrudes from the die board a distance that is less than or equal to a distance the knife element protrudes from the die board, classified in class 83, subclass 171.
  - III. Claims 16-23 and 25, drawn to a trim press including a die location pilot connected to the die board which engages a registration feature associated with the plastic article, a post element as the die location pilot that includes a generally conical recess that engages a protrusion on the plastic sheet, a die travel stop that includes a post element in proximity of the knife element, and a thermocouple for measuring the temperature of the knife, classified in class 83, subclass 128.
  - IV. Claim 24, drawn to a trim press including an electric circuit that provides an indication of the absence of thermoformable plastic, classified in class 156, subclass 359.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group I which includes a heater in direct contact with the knife element has a separate utility such as it could be used without the

die travel stop having a generally conical recess and a post element that protrudes from the die board a distance that is less than or equal to a distance the knife element protrudes from the die board of the invention of Group II; conversely, the invention of Group II which includes a die travel stop having a conical recess and a post element that protrudes from the die board a distance that is less than or equal to a distance the knife element protrudes from the die board has a separate utility such as it could be used without the heater that is in direct contact with the knife element of the invention of Group I. See MPEP § 806.05(d).

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group I which includes a heater in direct contact with the knife element has a separate utility such as it could be used without the die location pilot having a conical recess and the die travel stop having a post element in proximity of the knife element of invention of Group III; conversely, the invention of Group III which includes a die location pilot having a generally conical recess and a die travel stop having a post element in proximity of the knife element has a separate utility such as it could be used without the heater that is in direct contact with the knife element of the invention of Group I. See MPEP § 806.05(d).

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group II which a die travel stop having a generally conical recess and a post element that protrudes from the die board a distance

that is less than or equal to a distance the knife element protrudes from the die board has a separate utility such as it could be used without the die location pilot having a conical recess and the die travel stop having a post element in proximity of the knife element of invention of Group III ; conversely, the invention of Group III which includes a die location pilot having a conical recess and the die travel stop having a post element in proximity of the knife element has a separate utility such as it could be used without the die travel stop having a generally conical recess and a post element that protrudes from the die board a distance that is less than or equal to a distance the knife element protrudes from the die board of the invention of Group II. See MPEP § 806.05(d).

5. Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group I which includes a die travel pilot and a heater in direct contact with the knife element has a separate utility such as it could be used without the electric circuit that provides an indication of the absence of thermoformable plastic of invention of Group VI; conversely, the invention of Group VI which includes an electric circuit that provides an indication of the absence of thermoformable plastic has a separate utility such as it could be used without the heater that is in direct contact with the knife element. See MPEP § 806.05(d).

6. Inventions II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group II which includes a die travel stop having a generally conical recess and a post element that protrudes from the die board a distance

that is less than or equal to a distance the knife element protrudes from the die board has a separate utility such as it could be used without the electric circuit that provides an indication of the absence of thermoformable plastic of invention of Group VI; conversely, the invention of Group VI which includes an electric circuit that provides an indication of the absence of thermoformable plastic has a separate utility such as it could be used without the die travel stop having a generally conical recess and a post element that protrudes from the die board a distance that is less than or equal to a distance the knife element protrudes from the die board of the invention of Group II. See MPEP § 806.05(d).

7. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The invention of Group III which includes a die travel stop having a post element in proximity of the knife element and a thermocouple for measuring the temperature of the knife has a separate utility such as it could be used without the electric circuit that provides an indication of the absence of thermoformable plastic of invention of Group VI; conversely, the invention of Group VI which includes an electric circuit that provides an indication of the absence of thermoformable plastic has a separate utility such as it could be used without the die travel stop that includes a post element in proximity of the knife element and a thermocouple for measuring the temperature of the knife of the invention of Group III. See MPEP § 806.05(d).

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for

examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, restriction for examination purpose as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Comment*

11. It is noted that claims in groups I and III include both a die location pilot and a die travel pilot. If the die travel stop and the die location pilot are the same, how is possible that the trim press has two exact post elements with different names. For example, how is possible that independent claim 16 recites "a die location pilot" and dependent claim 22, which depends from claim 16, recites that the trim press as set forth in claim 16 further includes "a die travel stop". The die location pilot and the die travel stop include same exact post elements for limiting the travel of the trim. Therefore, It is not clear how the trim press can have two exact post elements that are called different names.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501.


The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).

GA/ga

March 2, 2005

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700